No. 95-26

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,

Petitioners,

v.

WESTVIEW INSTRUMENTS, INC.
AND ALTHON ENTERPRISES, INC.,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF OF LITTON SYSTEMS, INC., AS *AMICUS CURIAE* IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

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TABLE OF CONTENTS

TABLE OF AUTHORITIES

Cases

Statutory Provisions

Miscellaneous

INTEREST OF *AMICUS CURIAE*

With the consent of the parties,[1] *amicus curiae* Litton Systems, Inc. ("Litton"), hereby submits this brief in support of the petition for writ of certiorari filed by petitioners Herbert Markman and Positek, Inc. Although Litton has no interest in the outcome of the case at bar, it has a strong and abiding interest in the question presented: the constitutionally guaranteed role of the jury in patent disputes.

This question has wide ramifications and enormous practical importance for many parties. For example, Litton is a technology-based company whose business activities depend heavily on innovation and intellectual property. Accordingly, Litton is sometimes involved in patent litigation.[2] In availing itself of the protections of the patent system, Litton is entitled to the jury-trial rights granted by the Constitution.

INTRODUCTION AND SUMMARY OF ARGUMENT

In this Seventh Amendment case, the United States Court of Appeals for the Federal Circuit has held that "the interpretation and construction of patent claims, which define the scope of the patentee's rights under the patent, is a matter of law exclusively for the court." Pet. App. 5a.[3] Yet as the Federal Circuit stressed, interpreting a patent often requires weighing conflicting "expert and inventor testimony" bearing both on "'how those skilled in the art would interpret the claims,'" 31a (citation omitted), 33a, and on "the state of the prior art at the time of the invention." 33a. The court of appeals admitted that it was "using certain extrinsic evidence that the court finds helpful and rejecting other evidence as unhelpful, and resolving disputes en route to pronouncing the meaning of claim language." 36a. The court explained, for example, that the testimony of the inventor himself as to the

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[1] Letters reflecting written consent of the parties to the submission of this brief have been filed with the Clerk of the Court.

[2] *See, e.g., Litton Systems, Inc. v. Honeywell, Inc.*, Nos. 95-1242, 95-1311 (Fed. Cir.) (pending); *Jamesbury Corp. v. Litton Industrial Prods., Inc.*, 839 F.2d 1544 (Fed. Cir.), *cert. denied*, 488 U.S. 828 (1988); *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423 (Fed. Cir. 1984).

[3] Citations to the Appendix to the Petition for Certiorari are styled "__a."

meaning of his patent was entitled to "little or no probative weight in determining the scope of a claim." 47a-48a. Indeed, the Federal Circuit has previously observed that the interpretation of a patent's scope often requires a factfinder to "give consideration and weight to several underlying factual questions, including . . . the description of the claimed element in the specification, the intended meaning and usage of the claim terms by the patentee, what transpired during the prosecution of the patent application, and the technological evidence offered by the expert witnesses." *Tol-O-Matic, Inc. v. Proma Produkt-Und Mktg. Gesellschaft m.b.H.*, 945 F.2d 1546, 1550 (Fed. Cir. 1991).

In the decision below, however, the Federal Circuit designated as issues of "law" matters that are quintessentially *factual* disputes — here, disputes about the scope and meaning, within the legally relevant community, of words of art used to define a patented invention at the time of the patent filing. The result of this holding is that factual issues bearing on patent infringement, previously triable to a jury as of right, will now be decided by a trial judge and then re-decided *de novo* by the Federal Circuit.

But this case is not merely about the role of juries in deciding the scope of patent claims, or even their role in resolving factual disputes regarding "obviousness" and other issues bearing on patent validity. The court of appeals has held that factual issues subsumed or "mixed" in an overall legal question are to be withdrawn from the jury and decided by the court, or, if decided by the jury, may be freely re-examined by a reviewing court. This holding is wholly at odds with the Seventh Amendment. The central lesson of *Dairy Queen, Inc. v. Wood*, 369 U.S. 469, 470 (1962), and *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 511 (1959), is that an otherwise applicable right to jury trial cannot be lost simply because issues for the jury are intertwined with issues for the court. *See also Tucker v. Spalding*, 80 U.S. (13 Wall.) 453, 455 (1872) ("mixed question[s] of law and fact" relating to patent's scope "must be submitted to the jury"). The Federal Circuit's decision also ignores entirely the second part of the Seventh Amendment, the Re-Examination Clause, which provides that "no fact tried by jury, shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law." *See Parsons v. Bedford*, 28 U.S. (3 Pet.) 433, 447 (1830) (Story, J.).

Accordingly, the significance of the Federal Circuit's decision extends far beyond patent claim construction and even patent law. The decision goes to the fundamental distinction between law and fact and the role of that distinction in the operation of the Seventh Amendment generally. Under the decision below, courts may displace juries and arrogate to themselves the power to resolve factual issues whenever those issues are mixed with or immersed in legal questions. That decision raises square conflicts with the decisions of other courts of appeals and poses grave dangers to the Seventh Amendment, both in patent cases and in many (and perhaps most) other kinds of federal civil litigation.

There could be no better vehicle than this case for deciding the Seventh Amendment question presented. The Federal Circuit has made clear that the case under review is meant to be that court's definitive resolution of the constitutional issue. Eighteen months after the case was argued before a panel of the Federal Circuit — and before any decision had issued — the court took the unusual step of ordering, *sua sponte*, that the case be considered *en banc*. The court formulated four questions relating to the respective roles of judge and jury on which it requested additional briefing from the parties and from *amici*. The Federal Circuit then announced what it believed to be a grand reconciliation of supposedly "inconsistent statements" in its prior decisions "as to whether and to what extent claim construction is a legal or factual issue, or a mixed issue." 21a; *see also* 30a ("We settle inconsistencies in our precedent . . . . "). The particular details of the case under review need not detain this Court.[4] The constitutional question is cleanly presented, and no procedural obstacles would prevent this Court from deciding it.

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[4] It is immaterial whether the Federal Circuit was required to decide the far-reaching constitutional question in order to dispose of the instant case, or whether it might simply have held that there was no genuine dispute at all on this record. *See* 81a-82a (Rader, J., concurring in the judgment). The Federal Circuit has announced its conclusive resolution of the Seventh Amendment issue and has adhered to it in its subsequent decisions. *See Laitram Corp. v. NEC Corp.*, No. 94-1368, 1995 U.S. App. LEXIS 20649, *8 (Fed. Cir. Aug. 4, 1995); *Graco, Inc. v. Binks Mfg. Co.*, No. 93-1494, 1995 U.S. App. LEXIS, *13 (Fed. Cir. June 30, 1995); *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615 (Fed. Cir. 1995). It would be ironic if the breadth of the Federal Circuit's holding could serve to insulate it from this Court's review.

The scope of the constitutionally protected functions of the jury is a question that arises in almost every patent infringement case and, of course, in a vast array of civil litigation outside the patent area. This Court has already granted certiorari to review the question whether the Seventh Amendment requires a jury trial in a declaratory judgment action to have a patent declared invalid. *American Airlines, Inc. v. Lockwood*, No. 94-1660 (petition for certiorari granted June 5, 1995). The practical importance of the issue is further underscored by the fact that additional petitions for certiorari related to the instant case have been filed with this Court: *Pirkle v. Ogontz Controls Co.*, No. 95-45, and *United States Surgical Corp. v. Ethicon, Inc.*, No. 94-2081.

The need for certiorari is plain.

REASONS FOR GRANTING THE WRIT

This Court has long recognized the pivotal importance of the Seventh Amendment in our constitutional scheme,[5] a significance illustrated by its central role in the creation of the entire Bill of Rights.[6] The jury is, in the words of legal historian and Judge Morris Arnold, "the single most important institution in the history of Anglo-American law."[7] Accordingly, "[m]aintenance of the jury as a fact-finding body is of such importance and occupies so firm a

[5] *E.g.*, *Edmonson v. Leesville Concrete Co.*, 500 U.S. 614, 624 (1991); *Parkland Hosiery Co. v. Shore*, 439 U.S. 322, 338-44 (1979) (Rehnquist, now C.J., dissenting); *United States v. Wonson*, 28 F. Cas. 745, 750 (1812) (Story, Circuit Justice); Justice Clark, *The American Jury: A Justification*, 1 VALPARAISO L. REV. 1, 1-7 (1966).

[6] *See* Charles Wolfram, *The Constitutional History of the Seventh Amendment*, 57 MINN. L. REV. 639, 657 (1973) ("the entire issue of a Bill of Rights was precipitated at the Philadelphia Convention by an objection that the document under consideration lacked a specific guarantee of jury trial in civil cases"); Henderson, *The Background of the Seventh Amendment*, 80 HARV. L. REV. 289, 295 (1966) ("The almost complete lack of any Bill of Rights was a principal part of the Anti-Federalist attacks on the Constitution and the lack of provision for civil juries was a prominent part of this argument").

[7] *The Civil Jury in Historical Perspective*, in THE AMERICAN CIVIL JURY 9-10 (1987).

place in our history and jurisprudence that any seeming curtailment of the right to a jury trial should be scrutinized with utmost care." *Dimick v. Schiedt*, 293 U.S. 474, 486 (1935).

Yet the Federal Circuit's decision would jeopardize this constitutional guarantee in a broad category of cases. Judge Newman observed that "[t]his holding not only raises a constitutional issue of grave consequence, but the court creates a litigation system that is unique to patent cases, unworkable, and ultimately unjust." 84a (dissenting opinion). She filed a lengthy opinion exhaustively documenting the logical, historical, and constitutional flaws in the Federal Circuit's decision. *See* 84a-158a. Judge Mayer, writing separately, predicted that that the decision would lead to "turbulence and cynicism in patent litigation." 57a (opinion concurring in the judgment). He warned that the holding "jettisons more than two hundred years of jurisprudence and eviscerates the role of the jury preserved by the Seventh Amendment of the Constitution of the United States" and "marks a sea change in the course of patent law that is *nothing short of bizarre*." *Id.* (emphasis added).

Indeed, the Federal Circuit's efforts to ensure that *it* will have the ultimate authority to rule *de novo* on legally linked factual issues, such as issues of claim interpretation, runs afoul of weighty historical tradition: the Seventh Amendment was aimed in significant part at precisely such assertions of judicial power.[8]

More fundamentally, the decision below raises grave implications for the relationship between judge and jury in every area of federal litigation.

[8] *See* Judge Patrick Higginbotham, *Continuing the Dialogue: Civil Juries and the Allocation of Judicial Power*, 56 TEX. L. REV. 47, 48-50, 52 (1977) (arguing that the Seventh Amendment originated out of a need for a check on the otherwise unaccountable power of appellate courts and that American courts have a "peculiar need for the democratizing influence of the jury," because an independent judiciary carries with it an "attendant risk of autocratic behavior"); *see also Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 82 (1989) (White, J., dissenting); *Chauffeurs, Teamsters and Helpers, Local No. 391 v. Terry*, 494 U.S. 558, 580 (1990) (Brennan, J., concurring in part and concurring in the judgment).

I. THE DECISION BELOW CONFLATES THE DISTINCTION BETWEEN LAW AND FACT AND THREATENS THE ROLE OF THE JURY IN NON-PATENT AS WELL AS PATENT LITIGATION

1. Insofar as the governing substantive law makes a patent's construction turn in part on how a person schooled in the pertinent art would understand a particular term at the time of the invention, the law inescapably compels the resolution of a matter of *fact*.[9] If there is any genuine dispute as to that matter, its resolution involves the weighing of evidence and the evaluation of credibility. Indeed, although the resulting factual finding goes to the "interpretation" of disputed terms of a document, that interpretation merely informs — it does not inevitably determine — the "construction" of the document's operative legal effect.[10] The latter inquiry remains with the court, but it must be undertaken in accord with the jury's legally relevant, and sometimes decisive, findings of fact. Accordingly, the Federal Circuit has frequently recognized that "interpretation of a claim may depend upon evidentiary material about which there is a factual dispute, requiring resolution of factual issues as a basis for interpretation of the claim." *United States v. Telectronics, Inc.*, 857 F.2d 778, 781 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1046 (1989).[11]

Even in the decision below, the Federal Circuit observed that the focus of the inquiry was a question of historical fact: "what one of ordinary skill in the art *at the time of the invention* would have understood the term to mean." 48a (emphasis added). The kind of evidence cited by the court is the very kind that, if the subject of a genuine dispute, is normally regarded as peculiarly within the jury's domain: (a) expert testimony, "including evidence of how those skilled in the art would interpret the claims," 31a (citation omitted); (b) the language used in the patent's specification, which is a written description of the invention that is filed with the claim and that must enable one of ordinary skill in the art to make and use the invention, 31a-32a; (c) the history of the patent's prosecution in the Patent and Trademark Office, 32a-33a; and (d) other sorts of extrinsic evidence, such as sales literature and testimony of the inventor,

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[9] *E.g.*, *Tol-O-Matic*, 945 F.2d at 1550 (how much support is implied by term "provide for lateral support" in piston assembly); *H.H. Robertson Co. v. United Steel Deck, Inc.*, 820 F.2d 384, 389 (Fed. Cir. 1987) (whether "bottomless trench" design for electrical wiring covered assemblies in which only key portion of the trench was bottomless); *Moeller v. Ionetics, Inc.*, 794 F.2d 653, 656-57 (Fed. Cir. 1986) (whether term "electrode" included entire length of silver wire, or just tip); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 672 (Fed. Cir. 1984) (whether "recovered liquid hydrocarbon absorbent": (1) "means an undefined absorbent that is capable of recovering" liquid hydrocarbon; or (2) "means that the recovered liquid hydrocarbon is being used as an absorbent").

It would deny due process to change the rules of patent construction retroactively so that the actual meaning and scope of technical terms would not depend on the factual issue of how they are understood by one schooled in the relevant art. *Bouie v. City of Columbia*, 378 U.S. 347, 354-55 (1964).

[10] *See* 3 Arthur L. Corbin, CORBIN ON CONTRACTS § 534 (1960) ("By 'interpretation of language' we determine what ideas that language induces in other persons. By 'construction of the contract,' as that term will be used here, we determine its legal operation — its effect upon the action of courts and administrative officials."); RESTATEMENT (SECOND) OF CONTRACTS § 200 and Comment c (1981) (describing the distinction between "construction" and "interpretation" as reflecting the difference between the "meaning" of a term and its "legal effect"); *see also* 86a-92a (Newman, J., dissenting).

[11] *See also Arachnid Inc. v. Medalist Mktg. Corp.*, 972 F.2d 1300, 1302 (Fed. Cir. 1992) (although claim construction is issue of law for the court, it "may require the factfinder to resolve certain factual issues such as what occurred during the prosecution history"); *Lemelson v. General Mills Inc.*, 968 F.2d 1202, 1206 (Fed. Cir. 1992), *cert. denied*, 113 S. Ct. 976 (1993) (the "underlying factual issues in dispute become the jury's province to resolve in the course of rendering its verdict on infringement"); *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579 (Fed. Cir. 1989) ("A disputed issue of fact may, of course, arise in connection with interpretation of a term in a claim if there is a genuine evidentiary conflict created by the underlying probative evidence pertinent to the claim's interpretation. However, without such evidentiary conflict, claim interpretation may be resolved as an issue of law by the court . . . .") (citation omitted); *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 882 (Fed. Cir. 1988) (claim "interpretation may depend . . . on evidentiary material which requires resolution of factual issues, such as what occurred during the prosecution history"); *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985) (when the meaning of a claim term is disputed a "factual question arises, and construction of the claim should be left to the trier or jury under appropriate instruction."); *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 721-22 n.14 (Fed. Cir. 1984) ("claim construction, dependent on resolution of a factual dispute, does present a jury question").

which "may be helpful to explain scientific principles, the meaning of technical terms, and terms of art that appear in the patent and prosecution history." 33a.

To be sure, when a patent is clear, and when the evidence regarding its proper interpretation and construction does not give rise to a genuine factual dispute, the judge may rule on the construction of the claim as a matter of law. And, of course, in the optimal case there should be no ambiguity in claim language.[12] But when these ideals are not met, and when there are disputed factual questions bearing on a federal suit seeking damages for patent infringement, a jury must be called upon to resolve those factual questions — just as in any other area of the law when the underlying right to jury trial is not in doubt.

2. The Federal Circuit rejected that conclusion, as well as the Seventh Amendment principles that compel it. The court asserted that both "the *interpretation and construction* of patent claims" are "matter[s] of law exclusively for the court." 5a. The Federal Circuit thus held that, by classifying the *ultimate* question of patent claim *construction* as a "legal issue," it could ensure that any subsidiary factual questions of *interpretation* would be decided by a judge rather than a jury.

This reasoning, however, is both demonstrably fallacious and inherently uncontainable. Even if the construction of a patent's scope is, in the end, a legal issue, it simply does not follow that a judge rather than the jury should decide every issue of disputed fact that arises during the course of claim *interpretation* — or that a judge rather than the jury should have the last word in determining a genuine dispute over what a term or other element of the patent claim in fact *means* in the relevant community. After all, the ultimately legal questions of "negligence" in a tort case or the "reasonableness" of a restraint of trade in an antitrust case do not

[12] The patent statute mandates that specifications "contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same" and requires that the specification "shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. § 112.

authorize a judge to strip the jury of the power to decide subsidiary issues of fact.

The Federal Circuit's decision ignores a critical difference between (a) the traditional, and wholly Seventh-Amendment-compatible inquiry into what kinds of *lawsuits*, or *legal proceedings*, fall outside the historic category of "suits at common law" to such a degree that no jury trial right attaches, and (b) the entirely novel, and only superficially similar, Seventh-Amendment-*incompatible* inquiry into what kinds of *factual disputes*, embedded within lawsuits undeniably falling *inside* the historic jury-trial category,[13] nonetheless appear so "legal" in character that they may be carved out of the jury-trial right that otherwise indisputably applies.

The first inquiry is a familiar one that focuses on the nature of the litigation, including both the cause of action involved and the remedy sought. *See Chauffeurs, Teamsters and Helpers, Local No. 391 v. Terry*, 494 U.S. 558, 565 (1990); *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 42 (1989). But the second inquiry is incoherent from start to finish, inasmuch as *every* factual issue that arises in any trial *must* of necessity arise because it has some relevance to — that is, some logical bearing upon — a question of law that in turn governs, or at least contributes to, the resolution of the ultimate dispute.

Even under the first, conventional kind of Seventh Amendment inquiry, this Court has made clear that the right to jury trial on factual issues cannot be lost simply because those issues are submerged in legal or equitable questions to be resolved by a court. Thus, after lower courts had held that the presence of an equitable issue could eliminate the need to try a lawsuit before a jury,[14] this Court intervened to clarify that, when claims for damages are joined with a request for equitable relief, the right to jury trial, "including all issues common to both claims, remains intact." *Curtis v.*

[13] Judge Newman, in dissent below, ably showed that patent infringement actions were tried before a jury at common law, 118a-129a, a conclusion that the majority did not dispute. 44a.

[14] *E.g.*, 9 Charles Alan Wright & Arthur R. Miller, FEDERAL PRACTICE & PROCEDURE § 2302.1 (1973 & 1995 supp.).

Loether, 415 U.S. 189, 196 n.11 (1974) (discussing *Dairy Queen, Inc. v. Wood*, 369 U.S. 469 (1962), and *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500 (1959)).[15]

Just as lower courts, pre-*Beacon Theatres*, had erroneously held that a "dash of equity" could extinguish the right to jury trial, so the Federal Circuit has incorrectly held that the presence of a legal question, suitably mixed with the facts in dispute, could do the same. This error is even more egregious than that which led this Court to issue its course correction in *Beacon Theatres*, for "it would hardly take extraordinary ingenuity for a lawyer to find" questions of law mixed with questions of fact "at every turn in the road." *Sugarman v. Dougall*, 413 U.S. 634, 657 (1973) (Rehnquist, now C.J., dissenting) (discussing "insular and discrete" minorities). Thus, the Federal Circuit committed a truly fundamental error by failing to recognize that, whatever might be true of the line between "law" and "equity," legally relevant questions of fact about which there is a genuine dispute are *always* subject to the jury-trial right whenever the controversy in which the dispute arises is jury-triable under the Seventh Amendment — regardless of how the facts fit into, or "mix" with, the legal matrix of the overall controversy.

3. Because the Federal Circuit's error was so basic, the constitutional issue presented by this case cannot be restricted to claim construction,[16] or even to patent litigation. The Federal Circuit's novel and philosophically misguided approach to the

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[15] This Court decisively rejected any suggestion that "the right to jury trial may be lost" as to issues that might be characterized as "'incidental'" to matters decided by the court. *Dairy Queen*, 369 U.S. at 470. "[N]or can [the right to jury trial] be impaired by any blending" of jury and non-jury issues. *Scott v. Neely*, 140 U.S. 106, 110 (1891). Noting "the flexible procedures of the Federal Rules [of Civil Procedure]," *Beacon Theatres*, 359 U.S. at 511, this Court instructed the lower federal courts *first* to impanel a jury to resolve the issues within its domain, and *then* to decide the remaining questions consistent with the jury's verdict. *E.g.*, *Lytle v. Household Mfg., Inc.*, 494 U.S. 545, 550-51 (1990).

[16] In *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), for example, this Court explained that "the ultimate question" of whether a patent is valid as "nonobvious" is "one of law," even though there are underlying "factual inquiries" to be made by a jury.

law/fact distinction has profound implications for non-patent cases as well. Under the Federal Circuit's view, courts could always withdraw a subsidiary factual issue from the jury on the ground that the fact was simply a constituent element of a broader legal question. As one scholar has commented, transforming issues of "fact" into "law" is "drastic in that it amounts to a direct judicial assault on the prerogatives of fact finders."[17] The "classification of ultimate facts as questions of law amounts to a manipulation of the law-fact doctrine to take questions from the jury or to subject the trial level's resolution of questions to free appellate review."[18]

By holding that the submersion of a factual issue in an ultimately legal question gives a court the authority to decide the factual issue itself, without submitting it to a jury, the Federal Circuit would utterly eviscerate the first clause of the Seventh Amendment. Yet this Court has made clear that the Seventh Amendment "requires that questions of fact in common law actions shall be settled by a jury, and that the court shall not assume directly or indirectly to take from the jury or to itself such prerogative." *Walker v. New Mexico Railroad Co.*, 165 U.S. 593, 596 (1897); *see also Gasoline Prods. Co. v. Champlin Ref. Co.*, 283 U.S. 494, 498 (1931).

In addition, the Federal Circuit's approach would separately violate the second clause of the Seventh Amendment in cases where a jury has already decided disputed factual issues, such as the meaning that the relevant community would assign to an ambiguous patent claim term. The Federal Circuit held that such a determination would amount to a ruling on "a matter of law," to be re-examined freely by a district court and "reviewed *de novo* on appeal." 30a. But the Re-Examination Clause, which this Court has long understood to be a "substantial and independent clause" that is in fact "more important" than the preceding portion of the Amendment, *Parsons v. Bedford*, 28 U.S. (3 Pet.) 433, 447 (1830) (Story, J.), "not only preserves th[e jury trial] right but discloses a

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[17] Martin B. Louis, *Allocating Adjudicative Decision Making Authority Between the Trial and Appellate Levels: A Unified View of the Scope of Review, the Judge/Jury Question, and Procedural Discretion*, 64 N.C. L. REV. 993, 1018 (1986).

[18] *Id.* at 1028.

studied purpose to protect it from *indirect impairment* through possible enlargements of the power of reexamination existing under the common law." *Baltimore & Carolina Line, Inc. v. Redman*, 295 U.S. 654, 657 (1935) (emphasis added); *see also Colgrove v. Battin*, 413 U.S. 149, 155 n.6 (1973).

Accordingly, the Federal Circuit's decision flouts *both* clauses of the Seventh Amendment.

4. Not surprisingly, the decision below is also in square conflict with cases in other courts of appeals. The ruling conflicts with pre-Federal Circuit decisions of the regional courts of appeals holding that the "proper meaning" of a disputed patent term is "a factual issue to be determined by the jury."[19] Moreover, the Federal Circuit's decision cannot be reconciled with many cases in the other courts of appeals properly applying this Court's decisions in *Dairy Queen* and *Beacon Theatres* and recognizing that the immersion of subsidiary facts in a legal question does not give a court the power to usurp the role of the jury.[20]

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[19] *Control Components, Inc. v. Valtek, Inc.*, 609 F.2d 763, 770 (5th Cir.), *cert. denied*, 449 U.S. 1022 (1980); *see also Tights, Inc. v. Acme-McCrary Corp.*, 541 F.2d 1047, 1060 (4th Cir.) (in context of obviousness, "if an issue presents a mixed question of fact and law, it may be submitted if the jury is instructed as to the legal standard to be applied"), *cert. denied*, 429 U.S. 980 (1976); *Continental Conveyor & Equipment Co. v. Prather Sheet Metal Works*, 709 F.2d 403, 406 (5th Cir. 1983) ("We perceive no meaning to be assigned to these words [in the patent] as a matter of law. Rather, the interpretation of the phrase . . . was properly a jury determination"); *Hurin v. Electric Vacuum Cleaner Co.*, 298 F. 76, 78 (6th Cir. 1924) ("In case of a controversy as to the construction of a patent claim, it may usually be true . . . that a substantial issue of fact for the jury, resting on extrinsic evidence, is involved."); *Roberts v. Sears, Roebuck & Co.*, 723 F.2d 1324, 1338 (7th Cir. 1983) ("a factual dispute as to the meaning of a term of art used in the patent claim, the resolution of which required resort to expert testimony, properly would have been submitted to the jury"); *Hall Lab., Inc. v. Economics Lab., Inc.*, 169 F.2d 65, 66-67 (8th Cir. 1948) ("[T]he construction of patent claims where extrinsic evidence is required to determine the meaning of technical terms also involves questions of fact.").

[20] "[T]he legal claim . . . must be tried first before a jury and the equitable claim resolved subsequently in light of the jury's determination of the legal claim." *In re Lewis*, 845 F.2d 624, 629 (6th Cir. 1988). "[I]n a dual bench-jury trial the jury's verdict binds the judge with respect to any factual issues common to the jury-and judge-tried claims." *McKnight v. General Motors Corp.*, 908 F.2d 104,

The Federal Circuit's exclusive jurisdiction over patent appeals from district courts means, under the decision below, that the Federal Circuit will demand judicial trials of factual issues, as well as *de novo* judicial re-examination of facts found by juries, wherever the facts (or factual issues) bear directly on legal questions like claim construction, obviousness, or other aspects of patent validity — *even within circuits having controlling precedent to the contrary*, forcing district courts within these circuits into the Catch-22 of either violating the circuit law on which they are bound on all such procedural matters, or flouting the directive of the Federal Circuit under *Markman*. Yet the Federal Circuit itself has recognized that the same procedures should apply in patent cases as in other civil actions. *See, e.g., Allen Organ Co. v. Kimball Int'l, Inc.*, 839 F.2d 1556, 1563 (Fed. Cir.), *cert. denied*, 488 U.S. 850 (1988). The decision below not only violates that rule but puts district courts throughout the Nation in a wholly untenable position.

5. Although the constitutional dimensions of the right to jury trial are not matters falling within the special expertise of the Federal Circuit, this hardly gives that court license to ignore them. There is no special Seventh Amendment rule for patent cases. Indeed, the Federal Circuit's decision is in square conflict with decisions of this Court, which have long recognized that underlying factual disputes regarding the construction of a patent claim are to

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113 (7th Cir. 1990), *cert. denied*, 499 U.S. 919 (1991); *see also Bouchet v. National Urban League, Inc.*, 730 F.2d 799, 803-04 (D.C. Cir. 1984) (Scalia, J.); *Perdoni Brothers, Inc. v. Concrete Systems, Inc.*, 35 F.3d 1, 5 (1st Cir. 1994); *Song v. Ives Laboratories, Inc.*, 957 F.2d 1041, 1048 (2d Cir. 1992); *Wade v. Orange County Sheriff's Office*, 844 F.2d 951, 954 (2d Cir. 1988); *Cox v. Keystone Carbon Co.*, 861 F.2d 390, 394 (3d Cir. 1988); *Terry v. Chauffeurs, Teamsters & Helpers, Local 391*, 863 F.2d 334, 336, 338 (4th Cir. 1988), *aff'd*, 494 U.S. 558 (1990); *Roscello v. Southwest Airlines Co.*, 726 F.2d 217, 221 (5th Cir. 1984); *Brownlee v. Yellow Freight System, Inc.*, 921 F.2d 745, 749 (8th Cir. 1990); *Miller v. Fairchild Industries, Inc.*, 885 F.2d 498, 507 (9th Cir. 1989), *cert. denied*, 494 U.S. 1056 (1990); *Calnetics Corp. v. Volkswagen of America, Inc.*, 532 F.2d 674, 690 & n.26 (9th Cir.) (*per curiam*), *cert. denied*, 429 U.S. 940 (1976); *Tidwell v. Fort Howard Corp.*, 989 F.2d 406, 412 (10th Cir. 1993); *Lindsey v. American Cast Iron Pipe Co.*, 810 F.2d 1094, 1098 (11th Cir. 1987); *Williams v. City of Valdosta*, 689 F.2d 964, 976 (11th Cir. 1982).

be resolved by a jury where it is the trier of fact. *Silsby v. Foote*, 55 U.S. (14 How.) 218 (1852), for example, involved an appeal from a jury trial regarding a patent for an improvement in regulating the draft of stoves. The trial court determined that the patent covered "a combination of such of the described parts as were combined and arranged for producing a particular effect, viz., to regulate the heat of the stove." *Id.* at 225. But this legal construction of the patent claim still left some factual dispute as to the meaning of the patent's terms: what parts were necessary to regulate the heat of a stove? Accordingly, the trial court left to the jury the initial question of precisely which parts were covered by the claim as construed by the court. The defendants objected, "desir[ing] the Judge to instruct the jury that the index, the detaching process, and the pendulum, were constituent parts of this combination." *Id.* But this Court rejected that challenge: "How could the Judge know this as a matter of law? . . . [I]t therefore became a question for the jury, upon the evidence of experts, or an inspection by them of the machines, or upon both, what parts described did in point of fact enter into, and constitute an essential part of this combination." *Id.* at 226. This Court concluded that the trial court properly "left nothing but matter[s] of fact to the jury." *Id.* at 225.[21]

Similarly, in *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453 (1872), this Court held that a prior patent and related expert testimony on the issue of "diversity or identity" were improperly withheld from the jury, and described the issue as a "mixed question of law and fact" that "must be submitted to the jury, if there is so much

[21] The Federal Circuit maintained (at 54a) that *Silsby* is no longer good law, in the wake of 35 U.S.C. § 112, which requires patentees to set out specifications of their claims. *See* note 12, *supra*. But the statute represented less of a change than the court thought, since even the first Patent Act, in 1790, required that letters patent "describ[e] the said invention or discovery, clearly, truly, and fully." *See* 74a-75a (Mayer, J., concurring in the judgment); 131a-135a (Newman, J., dissenting). Moreover, the majority's logic is a *non sequitur*. Even if the adoption of Section 112 reduced the incidence of genuine factual disputes of the kind that arose in *Silsby*, it would not alter the fact that, *when* such disputes occur, they must be resolved by the jury. *See Granfinanciera*, 492 U.S. at 51 (even Congress "lacks the power to strip parties contesting matters of private right of their constitutional right to a trial by jury").

resemblance as raises the question at all." *Id.* at 455. "*[T]he ultimate response to the question must come from the jury.*" *Id.* (emphasis added). In *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1853), the trial court "construed" the claim in a general manner and left it for the jury to fill in the specifics. This Court affirmed the trial court's refusal to define the patent claim in its entirety, explaining that "where the whole substance of the invention may be copied in a different form, it is the duty of the courts *and juries* to look through the form for the substance of the invention — for that which entitled the inventor to his patent, and which the patent was designed to secure." *Id.* at 343 (emphasis added).[22]

Only when interpretation of the patent claims presents no factual question has this Court construed them as a matter of law.[23] A noted commentator explained that, "[w]hen the Claim itself refers to facts, the existence and character of which must be determined before the Claim can be construed, evidence concerning these facts may be submitted to the jury, whose finding thereon thus enters into

[22] *See also Coupe v. Royer*, 155 U.S. 565, 579-80 (1895) (holding that there was legal error in the trial judge's description of the invention to the jury and remanding for a new trial to the jury, but declining to give a peremptory instruction to the jury, on the ground that all of the differences are "the subject of legitimate consideration by the jury"); *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 814 (1870) (the meaning of disputed terms of art is "a question of fact for the jury"); *Wilson v. Barnum*, 49 U.S. (8 How.) 258, 261-62 (1850) (because disputes as to claim interpretation presented a question of fact, the Court had no jurisdiction to review an interlocutory appeal).

[23] *See, e.g., Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1903) ("it is apparent from the face of the instrument that extrinsic evidence is not needed"); *Heald v. Rice*, 104 U.S. 737, 749 (1881) ("if it appears from the face of the instruments that extrinsic evidence is not needed to explain terms of art . . . then the question of identity is one of pure construction, and not of evidence"); *Brown v. Piper*, 91 U.S. 37, 41, 44 (1875) (although evidence had been taken at trial, "[w]e think the patent was void on its face, and that the court might have stopped short at that instrument"); *Winans v. New York & Erie R.R. Co.*, 62 U.S. (21 How.) 88, 101 (1858) (there was only one construction of the patent "which the language of this specification will admit"); *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 484 (1848) ("without the aid of experts and machinists, [we have] no difficulty in ascertaining, from the language used here," the meaning of the patent).

and becomes an element in the interpretation of the Claim."[24]

II. THE SEVENTH AMENDMENT CANNOT BE CIRCUMVENTED BY RESORTING TO A SUPPOSED ANALOGY BETWEEN PATENTS AND STATUTES

The principal basis of the Federal Circuit's decision was an ill-considered analogy between patents and statutes. 51a-52a. The court's reasoning was fatally flawed.

1. The courts have long viewed patents as analogous not to statutes, but to contracts[25] or privately written deeds to property.[26] Any factual disputes bearing on ambiguities in these written instruments are resolved by the jury, not the court.[27]

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[24] 3 William C. Robinson, THE LAW OF PATENTS FOR USEFUL INVENTIONS § 1037 (1890) (emphasis added) (hereafter "ROBINSON ON PATENTS"); *see also* A.H. Walker, TEXTBOOK ON THE PATENT LAWS OF THE UNITED STATES OF AMERICA § 536 (4th ed. 1904) ("Where the question of infringement depends on the construction of the patent, and that construction depends upon a doubtful question in the prior art, the latter question should be left for the jury; and the dependent question of infringement should also be left for the jury to decide.").

[25] *See, e.g., Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880) (noting, in discussing construction of a patent, that "[t]he understanding of a party to a contract has always been regarded as of some importance in its interpretation"); *Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 1206 (Fed. Cir. 1992), *cert. denied*, 113 S. Ct. 976 (1993) ("While there may be underlying fact questions involved, the ultimate conclusion about the meaning and scope of a claim is, *like contract interpretation*, a question of law") (emphasis added); 1 ROBINSON ON PATENTS at §§ 15, 20 (explaining the longstanding analogy between patents and contracts, which originated in England in 1800 and was adopted in this country in 1831).

[26] *See, e.g., Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917).

[27] *See, e.g.*, Samuel Williston, A TREATISE ON THE LAW OF CONTRACTS § 616, at 649, 652 (3d ed. 1961) ("The general rule is that interpretation of a writing is for the court. . . . Where, however, the meaning of a writing is uncertain or ambiguous, and parol evidence is introduced in aid of its interpretation, the question of its meaning should be left to the jury"); *see also Reed v. Proprietors*

In many respects, a patent resembles a contract between the inventor and the government. In return for full disclosure of the invention, the government grants the patentee a restricted monopoly for a period of time. The sort of extrinsic evidence used in interpreting contracts is the same kind of evidence used in interpreting patent claims: custom and usage of the trade and course of dealing between the parties (akin to prior art), level of skill in the art, and events in the Patent and Trademark Office.

Alternatively, a patent may be thought of as a form of deed which sets out the metes and bounds of the property the inventor owns for the term and puts the world on notice to avoid trespass or to enable one to purchase all or part of the property right it represents.

2. The analogy between patents and statutes, in contrast, is a wholly inapt one. Patents are not "baby statutes," 80a n.8 (Mayer, J., concurring in the judgment), and the Patent and Trademark Office is not some "sort of junior-varsity Congress." *Mistretta v. United States*, 488 U.S. 361, 427 (1988) (Scalia, J., dissenting). For example, although a legislature is open and accountable to all, *see, e.g., Bi-Metallic Inv. Co. v. State Bd. of Equalization*, 239 U.S. 441, 445-46 (1915), the patent process is essentially private. "As patents are procured ex parte, the public is not bound by them . . . ." *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 279 (1877).

The Federal Circuit observed that patents are usually "enforceable against the public." 51a. But, of course, so are property rights and private contracts.[28] Moreover, the enforceability

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of Locks & Canals on Merrimac River, 49 U.S. (8 How.) 274, 289 (1850) (allowing jury to interpret vague or ambiguous deed, where "it necessarily becomes a fact for the jury to decide, whether the land in controversy is included therein").

[28] For example, almost all States recognize that third parties may not tortiously interfere in a private contractual relationship. *See* RESTATEMENT (SECOND) OF TORTS § 766 (1979); 43 Am. Jur.2d *Interference* §§ 12, 23, 29, 30, 31, 40, 57 (1968 & 1994 supp.); Annot., *Liability of Third Party for Interference With Prospective Contractual Relationship Between Two Other Parties*, 6 A.L.R.4th 195 (1994). In addition, the Federal Circuit's attempt to distinguish contract enforcement as an essentially "private" activity is unsustainable in light of the last half-century of state action doctrine. *See, e.g., Barrows v. Jackson*, 346 U.S. 249,

of patent claim interpretations against third parties is dictated by rules of claim and issue preclusion, not by the nature of a patent.[29]

3. The process of interpreting a patent's scope, when the issue is what the relevant community at the time of the patent's issuance would understand a particular term to mean, involves weighing evidence and evaluating credibility bearing on "what ideas [the patent's] language induces in other persons." 88a (Newman, J., dissenting) (internal quotation marks omitted). This interpretive inquiry most closely resembles the process of finding ordinary adjudicative facts, not of deciding legal questions, construing statutes, or even resolving matters of so-called "legislative fact." *See Lockhart v. McCree*, 476 U.S. 162, 168 n.3 (1986); Advisory Committee Notes to Fed. R. Evid. 201(a).

Indeed, how a particular term was understood in the relevant community at a given point in time is *precisely* the kind of adjudicative fact that, when legally relevant, is routinely submitted to a jury for resolution by empirical inquiry, *even in the statutory context*. It is simply incoherent to treat that question as though it involved a resolution, either *a priori* or as a matter of legal principle, of the effect that *ought* to be given to a particular written instrument. Thus, the Federal Circuit's argument would be flawed at its core even if patents *were* closely analogous to statutes.

Consider, for example, a federal statute analogous to the patent at issue in *Silsby v. Foote* — that is, a federal statute that created a civil cause of action for persons injured by defects in parts of stoves shipped in interstate commerce if those parts are "necessary to regulate the heat of the stove." A defendant in such a case would be entitled to have a jury consider the defense that the particular element of the stove that had injured the plaintiff was *not* one that was "necessary to regulate the heat of the stove," so long as there was a genuine factual dispute over the matter. *See Lytle*, 494 U.S. at 550; *Curtis v. Loether*, 415 U.S. at 196 n.11.

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254 (1953); *Shelley v. Kraemer*, 334 U.S. 1, 19-20 (1948).

[29] Under *Triplett v. Lowell*, 297 U.S. 638 (1936), patent validity could be relitigated in successive actions. It was only this Court's decision in *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*, 402 U.S. 313 (1971), that altered the rule of mutuality of estoppel. *See Cardinal Chemical Co. v. Morton Intern., Inc.*, 113 S. Ct. 1967, 1977 (1993).

The example is not merely hypothetical. This Court recently held, unanimously, that the securities laws require a jury to determine whether a given statement was "material" within the meaning of relevant statutes, on the ground that this is "a 'mixed question of law and fact' [that] has typically been resolved by juries." *United States v. Gaudin*, No. 94-514, 63 U.S.L.W. 4611 (June 19, 1995).[30] This Court has also held that "the underlying inquiry whether a vessel is or is not 'in navigation' for Jones Act purposes is a fact-intensive question that is normally for the jury and not the court to decide." *Chandris, Inc. v. Latsis*, 115 S. Ct. 2172, 2192 (1995). Other federal statutes operate in similar fashion.[31]

With respect to patents as with respect to some (but not all) statutes, the pre-existing substantive law, ultimately under the control of Congress, makes the interpretation of the terms of art employed in the instrument turn on what those schooled in the relevant fields would take those terms to mean at a given time. To the degree that the construction of a statute is instead deemed, as a matter of law, to be independent of the probable or actual understanding of those governed by it, this separation of legal construction from factual interpretation must, not only as a matter

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[30] *See also Schillner v. H. Vaughan Clarke & Co.*, 134 F.2d 875, 878 (2d Cir. 1943); *Stier v. Smith*, 473 F.2d 1205, 1208 n.9 (5th Cir. 1973); *James v. Gerber Prods. Co.*, 587 F.2d 324, 327 (6th Cir. 1978).

[31] A federal statute requires juries to determine whether an entity "acts for" an automobile manufacturer or is "under [its] control" — and thus is subject to liability under 15 U.S.C. § 1221(a) in suits by dealers. *See, e.g., Colonial Ford, Inc. v. Ford Motor Co.*, 592 F.2d 1126, 1129 & n.3 (10th Cir.), *cert. denied*, 444 U.S. 837 (1979). Copyright law vests the jury with authority to determine "substantial and material similarity" and other mixed questions of fact and law in infringement actions. *See, e.g., Rexnord, Inc. v. Modern Handling Systems, Inc.*, 379 F. Supp. 1190, 1196 (D. Del. 1974); *Blunt v. Patten*, F. Cas. No. 1579 (C.C.N.Y. 1828). Suits under the civil rights statutes involve a host of factual determinations submerged within legal questions as well. *See, e.g., Brisk v. Miami Beach*, 726 F. Supp. 1305, 1306 n.3 & 1309 (S.D. Fla. 1989) (application of qualified immunity in Fourth Amendment § 1983 case is a mixed question of law and fact that should be submitted to a jury); *Medcalf v. Kansas*, 626 F. Supp. 1179, 1188 (D. Kan. 1986) (whether failures of training and supervision amounted to gross negligence was a question of fact to be decided by jury in § 1983 case); *Morgan v. Labiak*, 368 F.2d 338, 340 (10th Cir. 1966) (reasonableness of force used by police officer is a question of fact for the jury).

of common sense but indeed as a matter of fundamental fairness and due process, be derived from a pre-existing substantive rule of construction that is clear enough to give fair warning to all those who might be held legally accountable for assuming the contrary. *See Marks v. United States*, 430 U.S. 188, 191 (1977); *Connally v. General Constr. Co.*, 269 U.S. 385, 391 (1939). Accordingly, the frequent irrelevance of adjudicative factfinding in statutory construction is a function not of anything magical about statutes that those instruments might have in common with patents, but rather of pre-existing rules of construction informing the world that statutes will not always be taken to mean what their addressees suppose — rules that have no counterpart in patent construction and rules that no federal court would have constitutional authority to promulgate. Even if a patent could properly be analogized to a statute, therefore, interpretation of a patent's meaning and scope in the course of a damage suit for patent infringement would necessarily remain a matter for a jury to decide.

CONCLUSION

The petition for writ of certiorari should be granted.

Respectfully submitted,

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